

Trademarks And The Likelihood Of Confusion

The basic test for both common law trademark infringement and infringement of a federally registered trademark is determined by the same analysis - Likelihood of Confusion.

Although the factors vary slightly, the basic components are the following:

- 1) Strength of plaintiff's mark;
- 2) Degree of similarity between the marks;
- 3) Degree of similarity between the goods/services;
- 4) Likelihood that plaintiff will bridge the gap;
- 5) Evidence of actual confusion;
- 6) Defendant's good faith in adopting mark;
- 7) Quality of defendant's products/services; and
- 8) Sophistication of buyers.

Strength of mark: The strength of the mark is determined by how distinctive the mark is in relation to the products or services offered under that mark. The more unusual or distinctive the mark, the longer the mark has been continuously used, the expense and effort in advertising - all go towards the strength of the trademark.

Degree of Similarity between the marks: The similarity between the two marks is a very important factor, and some of the criteria used to determine the overall impression created by a mark include the pronunciation, the translation of foreign words, the verbal translation of pictures, and the connotations of the mark.

Degree of Similarity between the goods/services: Substantially similar trademarks can co-exist as long as they are in differing goods or services. When the goods/services are directly competing, the allowable degree of similarity between the marks is lessened.

Likelihood of bridging the gap: This factor relates to the function and use of the goods or services, and whether the owner of the trademark may extend their mark into other goods/services or geographic regions. Documented plans and marketing data can be used to support the trend that the trademark owner operates and is growing in the business and extending geographic boundaries.

Evidence of actual confusion: All instances of misdirected mail, faxes, email and telephone calls, as well as any consumer complaints, are useful in assessing the public's level of confusion. A consumer survey is helpful to show public confusion.

Infringer's good faith in adopting mark: Although intent is difficult to prove, intent is always a factor. Any evidence that a party knowingly adopted a mark of another or otherwise acted in bad faith usually is the death knell for the infringer.

Quality of infringer's products: This relates more to a disparagement theory, where the goodwill in a mark is affected by the shoddy goods/services of the infringing mark.

Sophistication of consumers: The likelihood of confusion analysis is based on a reasonably prudent purchaser that is expected to exercise the 'degree of care, caution and power of perception' appropriate to the kind of choice he/she faces in marketplace. The law cannot protect indifferent buyers who do not buy on the basis of trademarks, as they are not affected by similar marks anyway. There are several factors that are analyzed including the price of the goods. The more expensive the services, the more discriminating the purchaser is likely to be, and likewise, a purchaser is likely to be hurried and careless for less expensive items.

Are you confused yet? Even the most astute trademark professionals can arrive at different conclusions depending on how they mix together these factors. As a trademark owner, you should continually monitor similar marks, and keep accurate records of all advertising and any misdirected calls or mail.

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